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MAR 19 2004

In re Application of:
Shunsuke Ohtsuda et al.
Serial No.: 09/937,185
Filed: September 21, 2001
Attorney Docket No. NSG-202US

DECISION ON PETITION

This is a decision on the petition, filed February 9, 2004, via facsimile transmission, requesting that the Amendment After Final Rejection be entered under 37 C.F.R. § 1.181 or § 1.182. The petition is being treated as a petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment of the above-identified application, to enter the Amendment After Final Action, to reset the statutory period for filing a reply to the final Office action to run from the mail date of any Advisory Action to be issued and to refund the fee for the three-month extension of time filed with the Notice of Appeal on December 17, 2003.

The petition ~~to~~ to withdraw the holding of abandonment is granted.
The petition to reset the period for reply to the final Office action is denied.
The request to refund the extension of time fee is granted.

This application was held abandoned for failure to timely file a response within the meaning of 37 C.F.R. § 1.113 to the final Office action of June 17, 2003. A Notice of Abandonment was mailed on January 27, 2004.

Petitioner asserts that a reply, consisting of an "Amendment After Final Action" was timely filed on August 6, 2003, but has not been considered by the USPTO. As such, petitioner requests that, due to the delay on the part of the USPTO, this amendment should be entered and that, if any Advisory Action is issued in response thereto, the shortened statutory period for reply be reset to run from the mailing date of such Advisory Action. It is further asserted that the delay in considering the Amendment After Final Action has caused the petitioner to have to pay the fee for an extension of time of three months to file the Notice of Appeal on December 22, 2003.

A review of the file record indicates that the above-identified Amendment After Final Action was timely submitted but was not matched with the file for consideration by the examiner. In

the apparent absence of an Office communication regarding the status of the Amendment After Final Action, a Notice of Appeal and a petition for an extension of time of three months were filed via a certificate of mailing under 37 CFR 1.8(a) with a deposit date of December 17, 2003, and were received in the USPTO on December 22, 2003.

STATUTE, REGULATIONS AND PRACTICE

37 C.F.R. § 1.113(a) states in part that:

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191) or to amendment as specified in § 1.116...

37 C.F.R. § 1.116(a) and (b) state that:

(a) After final rejection or action (§ 1.113) amendments may be made cancelling claims or complying with any requirement of form which has been made.

Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

M.P.E.P. § 706.07(f) states in part that:

All final rejections setting a three (3) month shortened statutory period (SSP) for response should contain one of the Form Paragraphs (7.39; 7.40; 7.41) advising applicant that if the response is filed within two (2) months of the date of the final Office action, the shortened statutory period will expire at three (3) months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable response period will be established. In no event can the statutory period for response expire later than 6 months from the date of the final rejection.

...

Advisory Actions

(4) Where the final Office action sets a variable response period as set forth in paragraph 1 above, AND applicant files a complete first response to the final Office action within 2 months of the date of the final Office action, the examiner must determine if the

...

(c) Response does not put the application in condition for allowance - then the advisory action should inform applicant that the SSP for response expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later, by checking the appropriate box at the top portion of the Advisory Action form, PTOL - 303.

...

For example, if applicant initially responds within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3 - month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

OPINION

In view of the copies of the postcard receipts evidencing the timely filing of the Amendment After Final Action on August 8, 2003 and of the Notice of Appeal on December 22, 2003, the copies of the Amendment and of the Notice of Appeal are hereby accepted since the USPTO has apparently lost the originally submitted papers.

Refund of the extension of time fee for filing the Notice of Appeal:

Pursuant to the USPTO policy on practice after final action as outlined in M.P.E.P. § 706.07(f), when a reply to a final Office action setting a three-month shortened statutory period for response is filed within two months of the date of the action, a variable response period will be established: the statutory period will expire at three months from the date of the final action or on the date the advisory action is mailed, whichever is later, but no later than six months from the date of the final action. The Amendment After Final Action submitted on August 6, 2003 was filed within two months from the date of the final action. Accordingly, a variable statutory period was established pursuant to M.P.E.P. § 706.07(f). In the instant application, the proposed after final amendment pursuant to 37 C.F.R. § 1.116 does not place the application in condition for allowance as indicated in the attached Advisory Action, the variable statutory period was extended to six months from the date of the final action and expired December 17, 2003. As such, the filing of the Notice of Appeal on December 22, 2003 via a certificate of mailing dated December 17, 2003 did not require an extension of time to be considered timely. The request for refund the fee for three-month extension of time filed December 22, 2003 is granted.

Resetting the statutory period in an Advisory Action:

Under current practice after an Office action is made final, it is incumbent upon an applicant to take appropriate steps to ensure against the abandonment of his/her application. Because the Amendment After Final Action submitted is not deemed to place the application in condition for allowance, the reply required may be a Notice of Appeal and requisite fee. While it is regrettable that the USPTO did not timely consider the After Final Amendment and an Advisory Action not mailed before the expiration of the statutory period, there is no provision in the statute or rule that permits resetting a statutory period in an Advisory Action. Accordingly, the petition to reset the time period for filing a reply to the final Office action cannot be granted.

Withdrawing the holding of Abandonment:

In view of the timely filing of the Notice of Appeal, the holding of abandonment is hereby withdrawn and the Notice of Abandonment vacated. The application is restore to the status of pending and under appeal. The appeal brief is due.

Time for filing an appeal brief:

Because the application was held abandoned while on appeal and because of the special circumstances surrounding this application, the two-month time to file the appeal brief pursuant to 37 C.F.R. § 1.192 is hereby reset to run from the date of this decision. Extensions of this time are governed by 37 C.F.R. § 1.136(a).

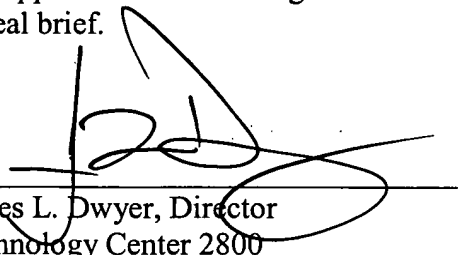
CONCLUSION

The holding of abandonment is withdrawn and the Notice of Abandonment vacated. The extension of time fee of \$950.00 will be refunded to Deposit Account No. 18-0350 and the two-month time for filing the appeal brief is reset to run from the date of this decision with extensions of time available under 37 CFR 1.136(a).

A copy of the Advisory Action is enclosed for petitioner's file record.

Questions regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.

The application file is being forwarded to the Technology Central Files where it awaits the appeal brief.



James L. Dwyer, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

Enclosure: Copy of the Advisory Action in response to the Amendment After Final Action